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3739

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named

Inventor : Dimitar V. Dimitrov

Appln. No. : 10/050,236

Filed : January 15, 2002

Title : METHOD FOR FORMING A MR READER
WITH REDUCED SHIELD TOPOGRAPHY
AND LOW PARASITIC RESISTANCE

Docket No. : I69.12-0526

Group Art Unit: 3729

Examiner:

Tugbang, Anthony D.

**PETITION FROM REQUIREMENT FOR RESTRICTION
PURSUANT TO 37 C.F.R. 1.144**

Mail Stop Petitions
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SENT VIA EXPRESS MAIL
Express Mail No.: EV 655620209 US

Petition

Applicant hereby petitions under 37 C.F.R. § 1.144 from the requirements for restriction entered in the Office Actions mailed on September 8, 2004 and June 14, 2005.

Reasons

In an Office Action mailed on September 8, 2004, the present application was restricted to claims 1-8 (Group I) directed toward a method of forming a magnetoresistive reader, claims 9-18 (Group II) also directed toward a method of forming a magnetoresistive reader, or claims 19-20 (Group III) directed toward a magnetoresistive reader. In an Amendment dated October 6, 2004, Applicant elected, with traverse, to pursue the Group I claims – in particular, disputing the propriety of the restriction requirement between Groups I and II.

In an Office Action mailed on December 30, 2004, the Examiner acknowledged Applicant's traversal of the restriction requirement, yet made the restriction requirement final. In an

Amendment dated March 24, 2005, Applicant again traversed the restriction requirement and added new claims 21-32.

In a Final Office Action mailed on June 14, 2005, the present application was further restricted to claims 2-5 (Group II) or claims 21-32 (Group III), with claim 1 indicated to be a linking claim between the two groups. Based upon prior prosecution, the Examiner found the invention of Group II to have been constructively elected. Applicant traversed this new restriction requirement in an Amendment dated August 15, 2005. The Requirements for Restriction were reaffirmed in an Advisory Action mailed on August 29, 2005.

Applicant respectfully petitions under 37 C.F.R. § 1.144 from the requirements for restriction entered in the Office Actions mailed on September 8, 2004 and June 14, 2005.

September 8, 2004 Restriction Requirement

The inventions of Groups I (claims 1-8) and II (claims 9-18) are not separate and distinct inventions requiring election therebetween. The method of independent claim 1 of Group I recites as steps:

- defining a stripe height back edge of a magnetoresistive sensor of the magnetoresistive reader; and
- subsequently defining a reader width of the magnetoresistive sensor.

The invention of this claim is generic to the inventive method of independent claim 9 of Group II, which includes as steps:

- selectively patterning a first photoresist layer...serving to define a stripe height back edge of the magnetoresistive sensor...;
- selectively patterning a second photoresist layer...serving to define a reader width of the magnetoresistive reader....

Thus, the inventions of Groups I and II are not distinct inventions.

In the September 8, 2004 Office Action, it is alleged that the inventions of Groups I and II are distinct because they have separate utility. Specifically, it is alleged that the invention of Group I requires the definition of a stripe height back edge not required of Group II, but independent claim 9 of

Group II specifies "the first photoresist layer serving to **define a stripe height back edge**". It is further alleged in the Office Action that the invention of Group II requires the use of first and second photoresist layers not required by Group I; however, dependent claims 2 and 3 of Group I recite the use of first and second photoresist layers. Because the invention of independent claim 1 of Group I is generic to the invention of Group II, and because the inventions of Group I and II do not have separate utility, this restriction requirement is improper and should be withdrawn.

It is alleged in the December 30, 2004 Office Action that claims 2 and 3 of Group I provide "no nexus between the patterning steps with the use of the first and second photoresist layers and the definition steps of the stripe height back edge and the reader width." This assertion ignores the plain language of the preamble which informs that the recited steps of claims 2 and 3 are performed specifically to achieve the action defined by the preamble, namely, "defining the stripe height back edge" in claim 2 and "defining a reader width" in claim 3. Because a nexus is provided in claims 2 and 3, the inventions of Group I and II are not separate and distinct and Applicant respectfully requests withdrawal of this restriction requirement.

June 14, 2005 Restriction Requirement

For the same reasons that Applicant traversed the requirement for restriction between the inventions of claims 1-8 and the invention of claims 9-18, Applicant further traversed the requirement for restriction between the invention of claims 2-5 (Group II) and the invention of claims 21-32 (Group III).

At paragraph 6 of the June 14, 2005 Office Action, it is asserted that the "[i]nventions of Groups II and III are related as subcombinations disclosed as usable together in a single combination." It is further asserted that "the invention of Group III has separate utility such as removing the first and second photoresist layers, not required in Group II" and that "[g]roup II has separate utility in that the first and second photoresist layers are layers that are formed with the final product of the magnetoresistive reader."

In response, Applicant pointed out that the invention of Group II does not require that the first and second photoresist layers be formed with the final product of the magnetoresistive reader. Claims 2-5 (and independent claim 1 from which these claims depend) each include the open-ended transitional

phrase "comprising", which is a term of art used in claim language to mean that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim. M.P.E.P. § 2111.03. The fact that these claims do not explicitly call for the removal of the first and second photoresist layers does not lead to the conclusion that the first and second photoresist layers must remain in the final product.

Applicant further disputed that the inventions of Groups II and III have separate utility. For example, both claim 2 of Group II and claim 21 of Group III recite steps for implementing the step of "defining the stripe height back edge of the magnetoresistive sensor" of independent claim 1.

In the Advisory Action, the Examiner maintained this second restriction requirement, averring as follows:

Group I [Group II] defines that the first photoresist layer and the second photoresist layer are patterned, while Group II [Group III] defines that the first resist layer serve to define a stripe height back edge and the second resist layer serve to define a reader width. Since they have different purposes (sic), Group I does not remove the layers, while Group II removes them. Examiner maintains his restriction requirement.

Dependent claim 2 of Group II recites that the step of "defining the stripe height back edge of the magnetoresistive sensor comprises", amongst other steps, "selectively patterning a first photoresist layer". In a similar fashion, dependent claim 21 of Group III recites that the step of "defining the stripe height back edge of the magnetoresistive sensor" comprises "selectively patterning a first photoresist layer". Applicant respectfully maintains that the inventions of Group II and Group III are not separate and distinct inventions requiring restriction therebetween.

Conclusion

Because the inventions defined by the restriction requirements entered in the Office Actions mailed on September 8, 2004 and June 14, 2005 are not separate and distinct inventions requiring election therebetween, and because these restriction requirements were timely traversed, Applicant respectfully petitions to have these restriction requirements withdrawn.

Respectfully submitted,

KINNEY & LANGE, P.A.

Date: 9/13/05

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FEE TRANSMITTAL



Total Amount of Payment \$130.00

Complete if Known

Application No.	10/050,236
Filing Date	January 15, 2002
First Named Inventor	Dimitar V. Dimitrov
Group Art Unit	3729
Examiner Name	Tugbang, Anthony D.
Atty. Docket Number	I69.12-0526

METHOD OF PAYMENT (Check One)

1. The Commissioner is hereby authorized to charge any additional fee required under 37 C.F.R. 1.16 and 1.17 and credit any over payments to Deposit Account No.11-0982. Deposit Account Name: Kinney & Lange, P.A. A duplicate copy of this communication is enclosed.

2. Check Enclosed

FEE CALCULATION

1. BASIC FILING FEE

Appn. Type	FILING FEE	SEARCH FEES	EXAM FEES	
	Fee/Small	Fee/Small	Fee/Small	FEES
PD.				
Utility	300 / 150	500 / 250	200 / 100	—
Design	200 / 100	100 / 50	130 / 65	—
Reissue	300 / 150	500 / 250	600 / 300	—
Provisional	200 / 100	-0- / -0-	-0- / -0-	—
				Subtotal (1) \$0.00

2. EXTRA CLAIM FEES

	Number Claims	Prior**	Extra	Fee from Fee Paid Below
Total	<u>20</u>	<u>20</u>	= <u>0</u> x <u>*</u> = <u>*</u>	
Indep.	<u>1</u>	<u>3</u>	= <u>0</u> x <u>*</u> = <u>*</u>	
Multiple Dependent Claims			<u>*</u> = <u>*</u>	

**Insert 3 and 20, or number previously paid if greater; Reissue see below

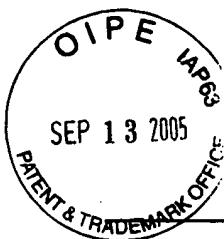
Large Entity Fee Code	Small Entity Fee Code	Description	
1202	50	2202	25
1201	200	2201	100
1203	360	2203	180
1204	200	2204	100
1205	50	2205	25
			Claims in excess of 20
			Independent claims in excess of 3
			Multiple Dependent Claim
			Reissue Independent Claims Over Original Patent
			Reissue claims in excess of 20 and over original patent
			Subtotal (2) \$0.00

FEE CALCULATION (Continued)

3. ADDITIONAL FEES

Large Entity Fee Code	Small Entity Fee Code	Fee Description	Fee paid
1051	130	Surcharge - Late filing fee or oath	*
1052	50	Surcharge - late provisional filing fee or cover sheet	*
1053	130	Non-English specification	*
1812	2,520	For Filing a Request for Reexamination	*
1251	120	Extension for reply within first month	*
1252	450	Extension for reply within second month	*
1253	1,020	Extension for reply within third month	*
1254	1,590	Extension for reply within fourth month	*
1255	2,160	Extension for reply within fifth month	*
1402	500	Filing a brief in support of an appeal	*
1403	1,000	Request for oral hearing	*
1814	130	Terminal Disclaimer Fee	*
1452	500	Petition to revive - unavoidable	*
1453	1,500	Petition to revive - unintentional	*
1501	1,400	Utility/Reissue issue fee	*
1502	800	Design issue fee	*
1460	130	Petitions to the Commissioner	130
1807	50	Petitions related to provisional applications	*
1806	180	Submission of Information Disclosure Statement	*
8021	40	Recording each patent assignment per property (times number of properties)	*
1801	790	Request for Continued Examination (RCE)	*
		Other fee (specify) _____	*
			Subtotal (3) \$130.00

Signature Dina M. Khaled Reg. No. 52,761
Dina M. Khaled
Date 9/30/05 Deposit Account No. 11-0982



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EXPRESS MAIL COVER SHEET

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The following papers are being transmitted via **EXPRESS MAIL** to the U.S. Patent and Trademark Office on the date shown below:

1. Petition from Requirement for Restriction Pursuant to 37 C.F.R. 1.144;
2. Fee Transmittal (in duplicate);
3. Check in the amount of \$130.00; and
4. Return receipt postcard.

Respectfully submitted,

KINNEY & LANGE, P.A.

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